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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,363	09/19/2000	Y. Tom Tang	789CIP2C	5054

7590 03/22/2002
Leslie A Mooi
Hyseq Inc
670 Almanor Avenue
Sunnyvale, CA 94085

EXAMINER

ARTHUR, LISA BENNETT

ART UNIT PAPER NUMBER

1634

DATE MAILED: 03/22/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/665,363

Applicant(s)

TANG ET AL.

Examiner

Lisa B. Arthur

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 21 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 10,11,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 10,11,20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. This action is in response to the paper filed February 21, 2002. Claims 1-9, 12-19 and 22-28 have been canceled in response to the restriction requirement made in the previous office action. Claims 10,11,20 and 21 are pending in this application.

2. Applicant's election of Group 41, a polypeptide encoded by SEQ ID No 6 in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 is indefinite over the recitation of the phrase "wherein the polypeptide is provided on an array" because this phrase makes the claims unclear as to whether the claim is drawn to a polypeptide or to an array containing the polypeptide.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

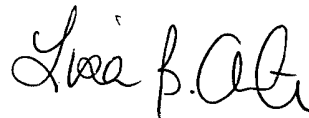
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10,11,20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kondo et al. (J. BIOCHEMISTRY (1999) 125(4): 818-825). Kondo et al. Teaches a polypeptide which is encoded by the nucleotide sequence of SEQ ID NO 6 (see Figure 2 and sequence alignment given in attachment A). Kondo et al. teach that these nucleotide acids encode human PMSL proteins which are homologs of bacterial MutL, a protein involved in mismatch repair (abstract). While Kondo et al. Do not teach a polynucleotide which consists of entire nucleotide sequence of SEQ ID NO 2, Kondo et al. does teach the polypeptide which is encoded by the nucleic acid of SEQ ID NO 6. SEQ ID NO 6 contains untranslated sequence (nucleotides 1-522) and two putative methionine residues as potential translation start sites, the first met at nucleotide 523 of SEQ ID NO 6 and the second met at nucleotide 586 of SEQ ID NO 6. However, Kondo et al. expressed the polypeptide encoded by a nucleic acid starting at nucleotide 563 of SEQ ID NO 6 and expressed a polypeptide whose first amino acid was the second met at nucleotide 586. As a result Kondo et al. teach a polypeptide encoded by the nucleotide sequence of SEQ ID NO 6. Although Kondo et al. do not teach a polypeptide whose first amino acid is the first met at coded by nucleotide 523, Kondo et al. still teaches the claimed polypeptide because the claims are not limited to a polypeptide starting at the first methionine. Applicant should note that The nucleotide sequence of Kondo et al. was available in 1998.

6. No claims are allowable over the prior art.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa B. Arthur whose telephone number is 308-3988. The examiner can normally be reached on Monday-Wednesday from 7:00 AM to 2:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for the organization where this application or proceeding is assigned is 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0196.


LISA B. ARTHUR
PRIMARY EXAMINER
GROUP 1800 1600

March 20, 2002